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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,169	02/08/2001	Eric P. Orgeron	A99274US (98062.3)	6510

22920 7590 10/02/2002

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EXAMINER

PIASCIK, SUSAN L

ART UNIT PAPER NUMBER

3643

DATE MAILED: 10/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/779,169

Applicant(s)

ORGERON ET AL.

Examiner

Susan L Piascik

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9 and 18-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 9, 18-24, and 25-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

PETER M. POON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION***Response to Arguments***

Applicant's arguments filed 7/16/02 have been fully considered but they are not found to be persuasive. The examiner maintains the rejections presented in the first office action. The applicant's invention lacks novelty in light of the prior art.

The applicant argues that the references used in the first office action fail to teach the claimed invention. However, the examiner disagrees with this argument, and finds the applicant's invention to read directly on the prior art cited in the previous office action. In regards to the Preston reference, the applicant states that the invention is not a float, as claimed, and fails to show a structure slidingly received on a rod. The examiner would like to suggest that the Preston reference could be considered a float since it contains a large void in the center of the lure, encapsulating a pocket of air. This is a feature found in all floats. Further, the body portion of the invention had to be "slidingly" received on the rod structure (21) in order to be constructed. Therefore, the examiner maintains that the Preston reference does in fact disclose the invention of the applicant's broadly stated claims.

Further, the examiner finds the Brokaw reference to teach the lure disclosed by the applicant. The applicant has modified the claim language in order to alter the originally stated "opening" to now disclose a "weighted tube means." However, the examiner finds the structure (50) shown in Figure 4 of the Brokaw reference to still be considered a weighted tube means. Brokaw discloses that the tube (50) may be constructed out of plastic or metal, both of which carry a significant "weight". Therefore, the examiner does not find the newly claimed term to read over the Brokaw reference. The applicant also argues that the tube means disclosed by

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Brokaw would position the lure in a vertical orientation in the water. However, this is not explicitly stated in the Brokaw reference. It is an assumption made by the applicant. The Brokaw reference shows the line being connected to the tail of the lure, in order to counter balance the motion in the front portion, similar to the applicant. The examiner would also like to point out that the applicant fails to positively claim the tube means being vertically inserted into the head of the lure. Also, the claim language of the applicant merely states "a tube means for causing the artificial bait body to be at a level position in the water while hanging on a fish line." The lure disclosed by Brokaw is capable of this limitation, as can be seen in Figure 4.

The applicant also argues that the Brokaw reference fails to teach whiskers. However, the examiner finds the disclosure to suggest any and all features of "hellgrammites, minnows, crawfish, shrimp, frogs, and other live bait" in column 1, lines 30-35. Though the figures do not show whiskers, it can be assumed that all features found on a shrimp would be obvious to include on an artificial model of the animal to one having ordinary skill in the art.

Finally, in response to the applicant's argument that there is no suggestion to combine the references, the examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. Prior art has shown that is well known in the art to combine floats with fishing lures, as shown in the previously cited Davis reference. The float allows for specific

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orientations of the lure when in a body of water. Therefore, the examiner finds the prior art to suggest motivation to combine the Brokaw and Preston reference.

In conclusion, the examiner wishes to maintain the rejections outlined in the previous office action, and restated below. Some modifications have been made in response to the applicant's amended claims. The prior art of record has shown that the applicant's claimed invention lacks novelty and further would have been obvious to one having ordinary skill in the art at the time of the invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

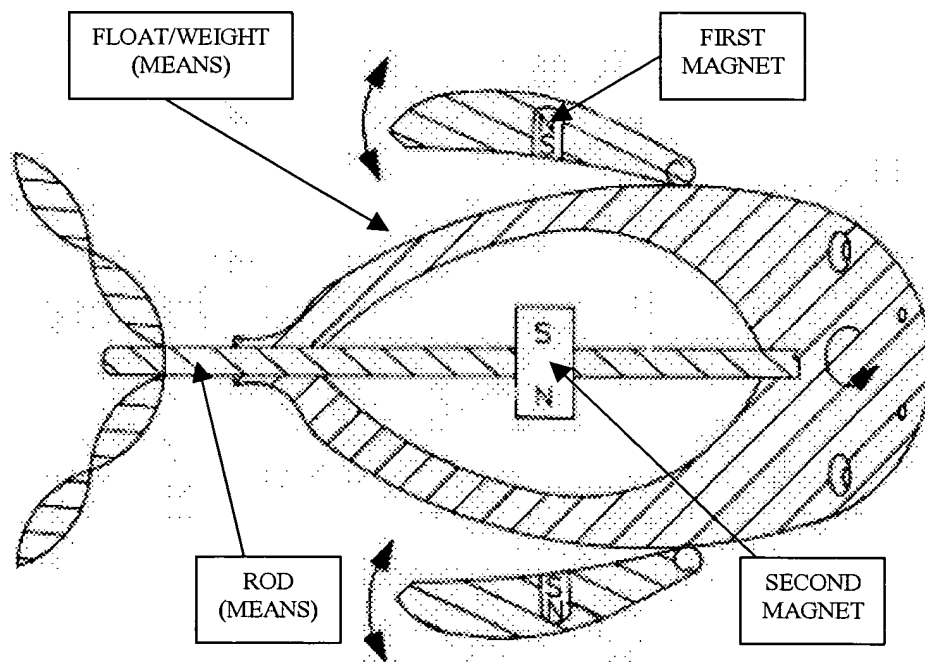
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim 9 is rejected under 35 U.S.C. 102(e) as being clearly anticipated by Preston.

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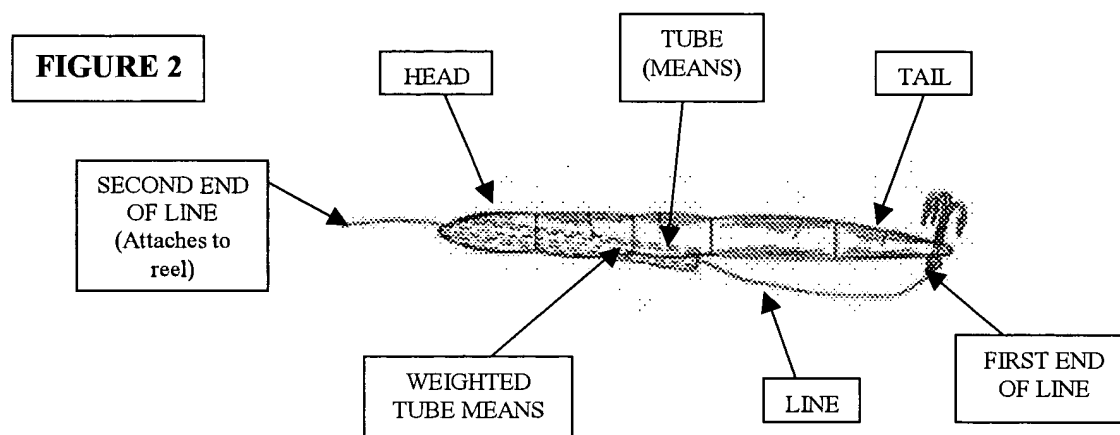
In regards to **claim 9**, Preston teaches an apparatus for making a sound similar to the slapping or clicking noise that a live shrimp makes when the tail section of the live shrimp makes contact with its body section comprising: a float (11) slidably received on a rod (16), a first magnet (24) attached to the float (11) and a second magnet (14) attached to the rod (16). The first (24) and second (14) magnets are aligned such that they repel one another (see col 2, lines 52-55). See Figure 1 below.

FIGURE 1

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Claims 18-24, 26-27, 31-34 and 39-40 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Brokaw.

In regards to **claim 18**, Brokaw teaches a fishing lure (2c) for use in water with a fishing line comprising an artificial bait body (unnumbered) having a tail (10) and a weighted tube means (50) in the body for allowing a line (14) to pass from the tail (10) of the artificial bait body (unnumbered) through the tube means (50) and for causing the artificial bait body to be at a level position in the water while hanging on a fishing line. See Figure 2 below.



Regarding **claim 19**, Brokaw discloses a fishing lure (2c) further comprising a line (14) passing from the tail (10) of the artificial bait body (unnumbered) through the weighted tube means (50).

In regards to **claim 20**, Brokaw teaches a fishing lure (2c) wherein the artificial bait body (unnumbered) has a head (8). The lure (2c) also has a weighted tube means (50) in the artificial bait body (unnumbered) positioned forward of the tail (10), generally in between the head (8) and the tail (10). The lure further comprises a flexible fishing line (14) or leader having first and

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second ends (unnumbered). The first end of the fishing line (14) is attached to the tail (10) of the artificial bait body (unnumbered) and the line (14) passes through the weighted tube means (50) wherein the second end of the fishing line (14) is connected to a fishing reel or to a length of fishing line wound upon a reel. See Figure 2 above.

Regarding **claim 21**, Brokaw discloses a fishing lure (2c) wherein the line (14) is a section of leader that has first and second ends (unnumbered). The first end is attached to the tail (10) of the lure and the second end defines a point of attachment for attaching a user's rod or reel thereto.

In regards to **claim 22**, Brokaw discloses a fishing lure (2c) further comprising a hook (24) attached to the lure body (unnumbered).

Regarding **claim 23**, Brokaw discloses a fishing lure further comprising a hook (24) attached to the line (14).

In regards to **claim 24**, Brokaw discloses a method of fishing using the lure (2c) of claim 18 to catch fish (see col 3, lines 49-75).

Regarding **claim 26**, Brokaw teaches a fishing lure (2c) wherein the artificial bait body (unnumbered) is an artificial shrimp body (see col 1, lines 30-34).

In regards to **claim 27**, Brokaw discloses a fishing lure (2c) further comprising a line (14) passing from the tail (10) of the artificial shrimp body through the tube means (unnumbered).

In regards to **claim 31**, Brokaw teaches a fishing lure (2c) wherein the artificial bait body (unnumbered) is an artificial shrimp body (see col 1, lines 30-34) and the tube means

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(unnumbered) is a tube for allowing a line (14) to pass from the tail (10) of the artificial shrimp body through the tube (unnumbered). See Figure 2 above.

Regarding **claim 32**, Brokaw discloses a fishing lure (2c) further comprising a line (14) passing from the tail (10) of the artificial shrimp body through the tube (unnumbered).

In regards to **claim 33**, Brokaw discloses a fishing lure (2c) wherein the artificial bait body (unnumbered) is an artificial shrimp body (see col 1, lines 30-34) and may include whiskers.

Regarding **claim 34**, Brokaw teaches a fishing lure (2c) further comprising a line (14) passing from the tail (10) of the artificial shrimp body (unnumbered) through the tube means (unnumbered).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 28-30 and 35-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brokaw in view of Preston.

In regards to **claim 28**, Brokaw discloses a fishing lure (2c) comprising an artificial bait body having a tail (10) and an opening (50) in the body for allowing a line (14) to pass from the tail (10) of the artificial bait body (unnumbered) through the opening (50). However, Brokaw

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fails to disclose a sound-making means for making a slapping or clicking noise in order to accurately simulate a live shrimp. U.S. Patent No. 5,924,236, given to Preston, does teach a lure (10) comprising a sound-making means for making a sound similar to the slapping or clicking noise that a live shrimp makes when the tail section of the live shrimp makes contact with its body section. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the lure disclosed by Brokaw, to include the sound-making means, taught by Preston, in order to make the fishing lure more realistic and attractive to fish species.

In regards to **claim 29**, Brokaw, as modified in the previous claim by Preston, teaches a lure wherein the sound-making means comprises a float (11) having a magnet (24) thereon.

Regarding **claim 30**, Brokaw as modified in claim 28 by Preston, teaches a fishing lure wherein the sound-making means comprises a float means (11) slidably received on a rod means (16). The sound-making means also comprises a first magnet (24) attached to the float means (11) and a second magnet (14) attached to the rod means (16). The first (24) and second (14) magnets are aligned such that they repel one another.

In regards to **claim 35**, Brokaw discloses a fishing lure (2c) that has an artificial body resembling a live shrimp body. However, Brokaw fails to disclose a sound-making means for making a slapping or clicking noise in order to accurately simulate a live shrimp. U.S. Patent No. 5,924,236, given to Preston, does teach a lure (10) comprising a sound-making means for making a sound similar to the slapping or clicking noise that a live shrimp makes when the tail section of the live shrimp makes contact with its body section. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the lure disclosed

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by Brokaw, to include the sound-making means, taught by Preston, in order to make the shrimp lure more realistic and attractive to fish species.

In regards to **claim 36**, Brokaw, as modified in the previous claim by Preston, teaches a lure wherein the sound-making means comprises a float (11) having a magnet (24) thereon.

Regarding **claim 37**, Brokaw as modified in claim 35 by Preston, teaches a fishing lure wherein the sound-making means comprises a float means (11) slidably received on a rod means (16). The sound-making means also comprises a first magnet (24) attached to the float means (11) and a second magnet (14) attached to the rod means (16). The first (24) and second (14) magnets are aligned such that they repel one another.

Regarding **claim 38**, Brokaw as modified in claim 35 by Preston, teaches a fishing lure wherein the sound-making means comprises a float (11) slidably received on a rod means (16). The sound-making means also comprises a first magnet (24) attached to the float (11) and a second magnet (14) attached to the rod means (16). The first (24) and second (14) magnets are aligned such that they repel one another.

In regards to **claim 39**, Brokaw, as modified in claim 28, teaches a fishing lure (2c) further comprising a tube means (unnumbered) in the opening (50) for allowing a line (14) to pass from the tail (10) of the artificial bait body (unnumbered) through the tube means (unnumbered). See Figure 2 above.

In regards to **claim 40**, Brokaw, as modified, teaches a fishing lure (2c) further comprising a line (14) passing from tail (10) of the artificial bait body (unnumbered) through the tube means (unnumbered). See Figure 2 above.

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Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan L Piascik whose telephone number is (703)305-0299. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon can be reached on (703)308-2574. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-7687 for regular communications and (703)305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-7687.

slp
October 1, 2002


PETER M. POON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600